

REMARKS

Claims 1-47 stand rejected as obvious over U.S. Patent No. 5,774,232 ("Tabata") in view of U.S. Patent No. 5,696,605 ("Miller") and U.S. Patent No. 5,752,053 ("Takakura").

Tabata teaches an electronic photocopier that optically scans a hard copy document. The photocopier determines the size of the hard copy document (e.g., A3 or B5 paper), and then prints the scanned image onto one or two sheets of paper of a standard size (e.g., A4 paper). The user can set the stapling position on the printed copy by selecting an option displayed on an LCD screen.

Miller teaches a laser based printing system. Like Tabata, Miller optically reads a hard copy document with a scanner section, and then copies the scanned image onto print media in a printer section 8.

Takakura teaches a document processing device that generates an electronic document in which text can be overlaid on a scanned picture using an alignment grid.

I. Comments on the Examiner's Response to Arguments

The Examiner argues as follows:

Moreover, the Applicants submit that "what is printed in Tabata does not contain any visual indicia of the assembly process" (p.2, lines 19-22). The Examiner disagrees with this assessment of Tabata, because Tabata in FIG. 13, col. 20, lines 57,65 Tabata shows 6 different visual displays ...

However, FIG. 13 of Tabata shows the LCD display, not what is printed by the photocopier. The material that is printed by Tabata's device does not contain any visual indicia of the assembly process.

The Examiner argues as follows:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which the applicant relies (i.e., Tabata does not teach displaying the scanned image on the LCD display screen" p.2, line 27) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.Cir. 1993).

First, Applicant was not arguing about teachings of the Applicant's specification, but about the teachings of Tabata. Thus, the Examiner's citation to case law is irrelevant.

Second, a person of ordinary skill in the art would understand that the document printed by Tabata's image forming section 108 is the document that was scanned by the image input

section 101 (possibly rotated and magnified). Consequently, a person of ordinary skill in the art would realize that in order for Tabata's screen 2404 to display the document *as if printed*, the screen 2404 would have to display the scanned image. However, a person of ordinary skill in the art would understand that Tabata's LCD display screen shows simple icons. Since Tabata's device prints the scanned image, Tabata's simple icons do not provide the appearance of the document *as if printed*. Therefore, a person of ordinary skill in the art would realize that Tabata's display screen 2404 does not show the visual appearance of the first electronic document as if printed and assembled in accordance with the instruction.

Since the Examiner does not dispute that Tabata teaches only simple icons rather than displaying the scanned image on the LCD display screen, the Examiner must also agree that Tabata's LCD display screen 2404 does not show the visual appearance of the electronic document as if printed and assembled in accordance with the instruction.

II. Comments on New Art

The Examiner cites Takakura for a program that determines the visual appearance of an electronic document as if printed. However, Takakura merely teaches a conventional document processing system in which specific pages can be given different formatting parameters (e.g., margins or alignment). The "print binding" discussed in Takakura are particular pages (e.g., the front and back pages) of the electronic document that need to be printed in a different format.

The phrase "by a single output instruction" emphasized by the Examiner is taken completely out of context. The full quote from the Takakura is that "one integrated document consisting of a plurality of pages can be output by a single output instruction." Thus, Takakura can print multiple pages having different format in a single print run. The "single output instruction" refers to clicking a print button, not to assembly instructions.

Nowhere is there any suggestion that Takakura shows the visual appearance of the electronic document as if printed and assembled in accordance with an instruction for assembling a hard copy document.

III. Obviousness

None of the reference show determining in the computer a visual appearance of the first electronic document as if printed and assembled in accordance with the instruction for assembling a hard copy document. In short, there is simply no suggestion from the references that an electronic document could be shown as it would appear once stapled, hole punched, or the like.

Nor does the prior art provided any motivation to combine or modify the references to yield a method that includes determining in the computer a visual appearance of the first electronic document as if printed and assembled in accordance with the instruction for assembling a hard copy document.

In view of the foregoing, Applicants submit that the claims are allowable and requests that the rejection of the of the independent claims be withdrawn.

Attached is a marked-up version of the changes being made by the current amendment.

Applicant asks that all claims be allowed. Enclosed is a \$110.00 check for the Petition for Extension of Time fee.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 7/30/01

David J. Goren
David J. Goren
Reg. No. 34,609

Fish & Richardson P.C.
2200 Sand Hill Road, Suite 100
Menlo Park, CA 94025
Telephone: (650) 322-5070
Facsimile: (650) 854-0875

Version with markings to show changes made

In the claims:

Claims 1 and 47 have been amended as follows:

1. (Twice Amended) A method of depicting a hard copy document, comprising:
receiving in a computer a first electronic document having a content;
receiving in the computer a user input that selects an instruction for assembling a hard copy document;
determining in the computer indicia of assembly and a visual appearance of the first electronic document as if printed and assembled in accordance with the instruction; and
[producing as output] displaying the determined visual appearance with the indicia of assembly overlaid with the content.
47. (Amended) A method of generating an assembled hard copy document, comprising:
receiving an electronic document having content and formatting information;
receiving a user input that selects an instruction for assembling a hard copy document;
determining a visual appearance of the electronic document once printed with the content arranged according to the formatting information and assembled in accordance with the instruction;
displaying the determined visual appearance;
receiving a user input accepting the determined visual appearance;
printing the electronic document with the content arranged according to the formatting information to generate a hard copy document; and
[assembled] assembling the hard copy document in accordance with the instruction.